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In re Application of
Lahn
Application No. 09/982,049
Filing Date: 16 October, 2001
Attorney Docket No. 000000 (sic)

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OFFICE OF PETITIONS

This is a decision on the petition filed on 12 May, 2004, and in light of the allegations considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED**.

BACKGROUND

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to the Restriction requirement mailed on 27 August, 2002, but damaged in the mail and re-mailed on 25 August (and, apparently again on 26 August), 2003, with reply due absent extension of time on 25 November, 2003;
- a result, the application was deemed abandoned after midnight 25 November, 2003;
- Notice of Abandonment was mailed on 24 March (and apparently again on 28 April), 2004;
- with the instant petition Petitioner included, *inter alia*: (a) his statement that the Office action was not received, and documents evidencing that, despite the Power of Attorney to

him submitted on original filing and the Notice of Change of Address appearing in the record and date-stamped as received by the Office on 15 August, 2002, the Office mailed the Restriction in the name of the Applicant (Richard H. Lahn) and to Petitioner's old mailing address;

- Petitioner has supplemented his petition with an Election as the reply to the Restriction.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁷

Petitioner has evidenced that the Office action was mailed to the wrong address, notwithstanding Petitioner's timely Notice to the Office. Thus Petitioner did not receive the Office action in question, and so satisfies the showing as required under 37 C.F.R. §1.181.

NOTES:

(1) Petitioner is reminded that the filing of one or more Status Inquiry(ies) at six-month intervals may evidence Petitioner's diligence in raising more quickly to the attention of the Office the possibility of Petitioner's non-receipt of materials mailed by the Office.


(2) Use of the Receipt Card (see MPEP §503) to evidence Office receipt of papers filed continues to be a prudent practice.

CONCLUSION

Because Petitioner satisfied the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 hereby is **granted**, the 24 March and 28 April, 2004, Notice(s) of Abandonment are **vacated**, and the petition fee is waived.

The file is held in the Office of Petitions to address another matter.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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Office of Petitions

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).